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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,613	10/28/2003	Lillian R. Paolino	P/113-14	6303
<div>Philip M. Weiss Weiss &amp; Weiss 300 Old Country Road Suite 251 Mineola, NY 11501</div>				
<div>7590 02/19/2009</div>				
<div>EXAMINER</div>				
<div>DANG, HUNG XUAN</div>				
<div>ART UNIT PAPER NUMBER</div>				
<div>2873</div>				
<div>MAIL DATE DELIVERY MODE</div>				
<div>02/19/2009 PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/695,613

**Applicant(s)**

PAOLINO, LILLIAN R.

**Examiner**

HUNG X. DANG

**Art Unit**

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/29/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **Claims Rejection Under 35 USC - 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Thayer et al (6,131,209)** in view of **Beames (D 466,543)**.

Thayer et al discloses eyewear comprises solid frames 60 having a lens; said frame 60 consisting of a one piece solid molded frame; said frames having a nose bridge which fits on top of a user's nose; said frames secured around a user's head by a single band 52; said band 52 secured to said frames 60 by two securing pieces wherein said band 52 is removed from said frame by either or both of said securing pieces wherein Velcro is used for both securing pieces; wherein said band 52 can be totally removed from said frames and replaced with other similar bands. (see at least figure 5 and the related disclosure.)

Thayer et al teach a single lens in the frame, Thayer et al does not teach that a pair of lenses as that claimed by Applicant.

Eyeglasses have long been designed with the general objective of correction the vision of the eye of the wears. Numerous designs of dual lens glasses and single lens glasses have been developed, differing only in aesthetic feature.

Beames, however, discloses the frames having a pair of lenses. Because Thayer et al and Beames are both from the same field of endeavor, the purpose of aesthetic feature as disclosed by Beames would have been recognized as an art pertinent art of Thayer et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Thayer et al, with a pair of lenses, such as disclosed by Beames for the purpose of the purpose of aesthetic feature.

### **Claims Rejection Under 35 USC - 103**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sadowsky (5,042,094).

Sadowsky discloses eyewear with prosthetic parts for small children comprises frame (30) for holding two lenses (20), the frame (the frame 30 is constructed with

Art Unit: 2873

resilient material, preferably also soft and pliable see column 3, lines 21 and 22) secured to a head by a band (40), said band (40) secured to the frames by two securing pieces (42) including Velcro is used for both securing pieces and the band (40) can be totally removed from the frame and replaced with other similar band (see figure 1 and the related disclosure.) Note that solid frame means the frame having the interior completely filled up and free from cavity, or not hollow.

### **Claims Rejection Under 35 USC - 102**

Claim 13 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Laschober** (4,930,885).

Laschober discloses eyeglasses with releasable headband support arrangement comprises one piece solid molded frame (14) for holding two lenses (16), the frame (14) having a nose bridge (18) with fits on top of the user nose, the frame (14) secured to a head by a band (28), said band (28) secured to the frames by two securing pieces (30), wherein the band (28) is removed from the frame by either or both of the securing means (see figures .1-4 and the related disclosure.)

### **Response to Applicant's argument**

Applicant's arguments filed 12/29/08 have been fully *considered* but they are not

Again, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or **in the knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case. Eyeglasses have long been designed with the general objective of correction the vision of the eye of the wears. Numerous designs of dual lens glasses and single lens glasses have been developed, differing only in aesthetic feature. Beames, however, discloses the frames having a pair of lenses. Therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Thayer et al, with a pair of lenses, such as disclosed by Beames for the purpose of the purpose of aesthetic feature. Therefore the claimed invention does not distinguish over the cited art.

Applicant argued that "Claim 13 requires that the sunglasses have solid frames having lenses. The frames consisting of a one-piece solid molded frame. The frame having a nose bridge and secured around a user's head with a single band. The band secured by two securing pieces. Sadowsky requires nose and temple pieces incorporated into the frame of the device. The device of the present invention does not have any temple pieces. The device of Sadowsky includes prosthetic appendages 34 and 36. Since the language of the claims is "consisting of" and Sadowsky adds extra

parts to their glasses which are outside the scope of the claims, the claims must be allowable over Sadowsky." This argument is not persuasive because the frame 30 could make by any plastic material (see column 3, lines 24 and 25). Thus the frame 30 is solid material. The prosthetic appendages 36 are parts of the frame, prosthetic appendages 36 and the frame is one piece (see column 3, lines 41 and 42). Therefore the claimed invention does not distinguish over Sadowsky device.

Applicant's argued that "The Examiner states that because Laschober teaches every feature of the claimed invention that it is prior art. With regards to a "consisting of" claim this goes against the MPEP and case law. The point here is that Laschober teaches other elements which go beyond the elements claimed in the present invention. Because of this, the claims must be allowable over Laschober.

Applicant points to section 2111.03 which relates to transition phrases including "comprising" and "consisting of". This section specifically states that the transition phrase "consisting of" excludes any element, step or ingredient not specified in the claim. Cite *In re Gray*, 53 F.2d 520, 11USPQ 225 (CCPA 1931). *Exparte Davis*, 80 USPQ448 (Bd. App. 1948).

*In Norian Corp. v. Stryker Corp.* Fed. Cir. 2004, the Court held that "consisting of" is a term of patent convention meaning that the claimed invention contains only what is expressly set forth in the claim.

*In Georgia Pacific v. United States Gypsum*, 195 F.3d 1322 Fed. Cir. 1999.

The Court described the MPEP as explaining the difference between "comprised" and "consists" as follows.

The transitional term "comprising"...is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.

The transitional phrase "consisting of" excludes any element step, or ingredient not specified in the claim.

Based on the MPEP and the case law cited above, because Laschober cannot make obvious the claims of the present invention.

Applicant believes the application is in condition for allowance."

This argument is not persuasive because the Laschober device teaches every features of the claimed invention. Laschober discloses eyeglasses with releasable headband support arrangement comprises one piece solid molded frame (14) for holding two lenses (16), the frame (14) having a nose bridge (18) with fits on top of the user nose, the frame (14) secured to a head by a band (28), said band (28) secured to the frames by two securing pieces (30), wherein the band (28) is removed from the frame by either or both of the securing means (see figures 1-4 and the related disclosure.) Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG X. DANG whose telephone number is (571)272-2326. The examiner can normally be reached on Monday to Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack, can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/09

/Hung X Dang/

Primary Examiner, Art Unit 2873